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09/628,146	07/28/2000	Nicolas Javier Di Prinzio	102	3537

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/628,146

Applicant(s)

DI PRINZIO, NICOLAS JAVIER

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 1-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 16 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1 and 21 have been amended for further examination

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12, 17, 18 and 22, are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (2,448,611).

Martin discloses in Fig. 3, 4 and 7, a magnetic clip marker comprising: a pair of rectangular wall members (6A and 6B, starting at point 12A and ending at fold line 22A to form wall member 6A; and starting point 12B which ends at 22B to form 6B as seen in Fig. 7) joined together (with strip 18, which forms a throat), wherein the wall members include a base portion (6A) and a clip portion (6B) completely overlying the base portion (6A, as seen in Fig. 2) to define a throat (seen in Fig. 7 which occupies triangle (12A-24-12B) and arranged to receive a page of a book; magnetic members (10) aligned with respect to one another and mounted to the base portion and the clip portion; a cover member (12A and 12B, seen in Fig. 4) or wedge members covering the magnetic members (10) on the overlapping base and clip portions to permit and guide the page (4) of the book to be received within the throat of the clip marker; external surfaces of the page marker provides an application for graphic prints or embossments (as seen in Fig. 1 and in Col. 1, lines 40-41); a signaling tab member <sup>or outer cover member</sup> (as seen in Fig. 1 and 7, in which the tab member starts at fold line (22) and ends at fold line (16)) which extends outwardly from the joined pair of wall members; and wherein the cover member (12A and 12B) covers both the magnetic members and the surfaces of the overlapping base and clip portions. However, Martin does not disclose: a clip portion overlapping a base portion; a cover member being a film made of plastic

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or cellulosic material; the wall members are circular; and wherein the base portion or clip portion has a greater length than the other.

In regards to **Claim 1**, it would have been an obvious matter of design choice to make the different portions of the clip portion of whatever form or shape was desired or expedient to overlap the base portion. **A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.** *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 7 and 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover members of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claim 10**, it would have been an obvious matter of design choice to make the different portions of the wall members of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claim 12 and 22**, it would have been an obvious matter of design choice to construct the wall members, the base or clip portion in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is

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generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

3. Claims 13 and 14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view Johnson.

Martin discloses a clip marker having all the elements as set forth in Claim 1 and as set forth above. However, Martin does not disclose at least one of the base or clip portion including an opening of ornamental design form.

Johnson discloses in Fig. 1 and 3, a clip marker having an opening (12) of an ornamental form to provide a line identification.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martin's clip marker to include an opening as taught by Johnson for the purpose of defining an index member associated with the opening.

In regards to **Claim 13**, a recitation of the intended use ("to provide a line identification on the page") of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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4. Claim 15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Schwartz.

Martin discloses a clip marker having all the elements as set forth in Claim 1 and as set forth above. However, Martin does not disclose an external surface of the clip marker having an exterior surface oriented to bear a device providing a visual display for information

Schwartz discloses a clip marker (Fig. 22 and Col. 8, lines 60-68) oriented to bear a device providing a visual display of information (see Col. 4, lines 1-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Martin's clip marker to include a wall member surface oriented to bear a device providing a visual display of information as taught by Schwartz for the purpose of providing a supplement to be used to coincide with information in the book.

***Allowable Subject Matter***

5. Claims 16 and 19 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 20 and 21 are allowed.

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7. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a magnetic clip marker comprising: magnetic members, a pair of wall members exhibiting a normally closed orientation with opposite surfaces of the wall members providing a continuous interior surface extending between a throat and terminal ends of the wall members; a cover member disposed along the interior surface to form a continuous layer extending from a first terminal end and around the throat and to a second terminal end; and including all of the other limitations of the independent claim.

### *Response to Arguments*

8. Applicant's arguments filed on June 29, 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that the Martin reference does not disclose: the contact between the "magnetic members in combination with the cover member...to permit the page of the book to be readily received with the throat of the clip marker;" and wherein the combination of the base permits "the page of the book to be readily received within the throat of the clip marker" the examiner submits that the Martin reference does indeed depict: contact between the magnetic members in combination with the cover members (as seen in Fig. 4, 5, 7



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and 6) to permit the page (4) of a book to be received in the throat (as described above); and a book page (4) being received in the throat of a clip marker as shown in Fig. 7 and 6, wherein the page stops at the end of the throat (point 24).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein the combination of the base and clip portion contributes to "the ease" of insertion of the page; and wherein the overlapping enables the extension and the clip portion "to receive and guide the edge of the page between the contacting magnets) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the Martin reference does not disclose a base portion and a clip portion overlapping each other and defining a throat between and structurally arranged to receive a page of a book, the examiner submits that the Martin reference discloses a base portion, an overlying clip portion and a throat in between wherein the clip marker is arranged to receive a page. Although the clip portion does not overlap the base portion (in which the size of the clip portion is greater, but not equal to the base portion), it would have been an obvious matter of design choice to make the different portions of the clip portion of whatever form, shape and size was desired or expedient to overlap the base portion. Furthermore, applicant does not state in the claims why it would be critical to do so. **A change in form or shape is generally**

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**recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.**

Since applicant has not disclosed the clip marker in detail, the examiner has rejected the claim limitations as best understood.

### ***Conclusion***

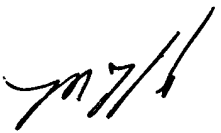
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

August 7, 2002



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